IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT :	Lundy LEWIS	CONFIRMATION NO.:	4279
SERIAL NUMBER :	09/578,156	EXAMINER:	Jeffrey R. Swearingen
FILING DATE :	May 23, 2000	ART UNIT:	2145
FOR :	METHOD AND APPARATUS FOR EVENT CORRELATION IN SERVICE LEVEL MANAGEMENT (SLM)		

Appellant's Reply Brief Under 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. Introduction

Appellant is filing this Reply Brief within two months of the Examiner's Answer dated December 26, 2007 (hereinafter "Answer"). This Reply Brief responds to the new points that the Examiner has raised in response to Appellant's Brief on Appeal filed October 30, 2007 (hereinafter "Appeal Brief").

II. Status of Claims

(1) Claims 1, 6, 8, 11, 13-14, 18, 20-23, and 26 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

(2) Claims 1-6, 9-13, 15-18, and 20-26 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,336,139 to Feridun et al. ("Feridun").

*****

(3) Appellant notes that claim 1 stands rejected under the judicially created doctrine of non-statutory obviousness-type double patenting as allegedly being unpatentable over claim 1

of U.S. Patent No. 6,430,712. However, Appellant will consider filing a Terminal Disclaimer to overcome this rejection once otherwise patentable subject matter has been determined.

Appellant further notes that filing a Terminal Disclaimer to obviate a rejection based on non-statutory double patenting does not constitute an admission of the propriety of the rejection. *See Quad Envtl. Techs. Corp. v. Union Sanitary Dist.*, 946 F.2d 870 (Fed. Cir. 1991).

III. Response to Examiner's Arguments

A. *The Examiner's Arguments Regarding the Rejection Under 35 U.S.C. § 112, Second Paragraph Fail to Cure the Deficiencies Thereof as Addressed in the Appeal Brief.*

In the Answer, the Examiner continues to allege that "there is no information within the specification to indicate any parameters that can be reasonably used by one or ordinary skill in the art to determine whether a service is in a desirable or undesirable state." Answer at 6. The Examiner's allegations in this regard fail to cure the deficiencies of this rejection, as addressed in the Appeal Brief, for various reasons.

For example, even the Examiner's characterization of the specification contradicts the allegation that "there is no information within the specification to indicate any parameters" relating to desirable or undesirable states of a service (e.g., on page 6 of the Answer, the Examiner acknowledges that "Applicant makes broad reference to obtaining a 'desired state' at various points of the specification"). Furthermore, Appellant's specification addresses in great detail the parameters and other criteria that informs whether a state may be considered "desirable" or "undesirable." For instance, the specification discusses at length that a "service level is some value of a service parameter used to indicate acceptable service qualities," and that a service level management system "can be designed to provide a desired level of services" (Page 20, lines 29-30; and Page 25, lines 7-8).

Despite the fact that the specification clearly indicates that the "state of a service may be defined by one or more service parameter values," and that a service parameter "represents the performance of some service provided by a network" (Page 20, lines 11-21), the Examiner nonetheless alleges that these passages "do not shed light on what would be a

'desirable state' or what factors one of ordinary skill in the art could apply to determine the desirability of a state." Answer at 6.

The Examiner's arguments essentially overlook the fact that which parameters and factors are to be considered in determining the desirability or undesirability of a given service state may depend on, among other things, "the way in which a business coordinates and organizes work activities and information to produce a valuable commodity" (Page 19, lines 25-30). Thus, where a business process includes one or more services that depend on one or more network components, the owner of the business process can generally "identify measurable parameters by which accomplishment of the desired services can be monitored and/or controlled" (Page 19, lines 10-12).

In other words, what may be considered an undesirable service state in one set of circumstances may be considered a desirable service state in another set of circumstances. As would be apparent to a person having ordinary skill in the art, the claimed invention sets forth a system and method wherein the desirability or undesirability of a service state may be determined by analyzing events and alarms in a network system. To that end, the "state of a service may depend, for example, on a collection of service parameter values for availability, reliability, security, integrity and response time" (Page 20, lines 11-18). For example, one business process may define the desirability of a service state based on a measure of network response time, while another may define the desirability of a service state based on a measure of availability for a given network resource. Furthermore, various business processes may implement distinct parameters or factors to be considered when measuring the network response time or availability of network resources.

Therefore, a person having ordinary skill in the art would readily discern that whether a state of a given service is "desirable" or "undesirable" depends on the specific service being implemented, the network components supporting the service, and the mapping between events generated by network components and the state of the service. The Examiner has therefore failed to apply the proper legal standard, where "claim definiteness . . . depends on the skill level of a person of ordinary skill in the art," and where a "person of ordinary skill is also a person of ordinary creativity, not an automaton." *See AllVoice Computing P.L.C. v.*

Nuance Commc'ns. Inc., 504 F.3d 1236 (Fed. Cir. 2007). Specifically, the Examiner's allegation of indefiniteness in relation to the terms "desirable" and "undesirable" fails to consider the nature of a service state as it would be understood by a person of ordinary skill in the art, as the specification clearly sets forth various ways in which service states can be measured and evaluated in relation to values that indicate the "desirability" or "undesirability" thereof.

Accordingly, for at least the foregoing reasons, the Examiner's arguments in the Answer fail to cure the deficiencies of this rejection addressed in the Appeal Brief. For at least this reason, the rejection of claims 1, 6, 8, 11, 13-14, 18, 20-23, and 26 under 35 U.S.C. § 112, second paragraph is improper and must be reversed.

B. *The Examiner's Arguments Regarding the Rejection Under 35 U.S.C. § 102(e) Fail to Cure the Deficiencies Thereof as Addressed in the Appeal Brief.*

In the Answer, the Examiner alleges that "Applicant admits Feridun's events can be considered as alarms." Answer at 7. The Examiner has mischaracterized Appellant's discussion of Feridun, as Appellant has not admitted that the events discussed in Feridun can be considered alarms. Rather, Appellant noted that Feridun generally describes a system that "acts to 'correlate' events, typically from disparate sources, to trigger some given action" (col. 9, lines 41-42). For instance, Feridun indicates that "a given software agent may have associated therewith a set of state machines each of which . . . recognizes a given 'pattern' of one or more events" (col. 9, lines 58-60).

Thus, in the Appeal Brief, where Appellant stated that "Feridun relates, at best, to an event correlator that uses software agents to analyze events to determine when given conditions (e.g., correlated events or alarms) have occurred," this statement did not admit events and alarms to be equivalents. To the contrary, this statement indicated that Feridun discusses "correlated events," which may, at best, be considered similar to "alarms" generated as a function of detected events, as recited in the claimed invention. However, Appellant further noted that Feridun does not address the subsequent processing that may occur for "correlated events" generated therein.

For instance, Feridun specifies that "a given event correlator at a node in the network is coupled to some other utility or routine that takes a given action when the correlator matches

some given event stream (or a set of streams)" (col. 10, lines 5-11). However, Feridun clearly states that the "particular details of the utility or routine **are not part of the present invention**" (col. 10, lines 11-12) (emphasis added). Rather, Feridun merely indicates that the output generated by an event correlation engine is placed in an output queue (e.g., Figure 8), and that some other utility or routine could process such output. However, Feridun does not disclose that the correlated events placed in the output queue are analyzed to determine "a current state of the service," as recited in the claimed invention, nor do the various passages that the Examiner has alleged to teach this feature.

Accordingly, for at least the foregoing reasons, the Examiner's arguments in the Answer fail to cure the deficiencies of this rejection addressed in the Appeal Brief. For at least this reason, the rejection of claims 1-6, 9-13, 15-18, and 20-26 under 35 U.S.C. § 102(e) as allegedly being anticipated by Feridun is improper and must be reversed.

C. *The Examiner's Arguments Regarding the Double Patenting Rejection Improperly Mischaracterize Appellant's Position.*

In the Answer, the Examiner alleges that Appellant has "failed to argue the double patenting rejection," and in reliance on this assertion, the Examiner alleges that "therefore [Appellant] has conceded this rejection is proper." Answer at 7. The Examiner's allegations in this regard improperly mischaracterize Appellant's position in relation to the double patenting rejection.

More particularly, since the Examiner initially raised the non-statutory double patenting rejection in the Office Action dated January 26, 2006, Appellant has consistently noted that the filing of a Terminal Disclaimer would be considered once otherwise patentable subject matter has been determined. Further, in the Response dated November 21, 2006, the Response dated February 22, 2007, the Appeal Brief, and in the Status of Claims provided above in Section II, Appellant has consistently noted that the filing of a Terminal Disclaimer to obviate a rejection based on non-statutory double patenting does not constitute an admission that the rejection is proper. *See Quad Envtl. Techs. Corp.*, 946 F.2d at 874 ("In legal principle, the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection. **It is improper to**

convert this simple expedient of 'obviation' into an admission or acquiescence or estoppel on the merits.") (emphasis added).

Accordingly, for at least the foregoing reasons, the Examiner has improperly alleged that Appellant has conceded the propriety of the non-statutory double patenting rejection. To the contrary, Appellant has consistently reserved the right to file a Terminal Disclaimer to obviate the rejection once otherwise patentable subject matter has been determined. As such, the Examiner's allegations run contrary to Appellant's legally recognized right to file a Terminal Disclaimer to obviate a non-statutory double patenting rejection without admitting, acquiescing, or otherwise being subject to estoppel on the merits. For at least these reasons, the Examiner's allegation that Appellant has conceded the propriety of the non-statutory double patenting rejection is legally improper and must not be given weight.

Conclusion

For at least the foregoing reasons, Appellant respectfully appeals to this Honorable Board to promptly reverse the rejections, and to issue a decision in favor in Appellant, as all of the pending claims are in condition for allowance.

Date: **February 26, 2008**

Respectfully submitted,

By: 

S. Jafar Ali
Registration No. 58,780

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Main: 703-770-7900
Fax: 703-770-7901